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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,256	09/10/2003	Tsung-I Yu	YUTS3014/EM	4016

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EXAMINER

ALTER, ALYSSA M

ART UNIT PAPER NUMBER

3762

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/658,256

Applicant(s)

YU, TSUNG-I

Examiner

Alyssa M. Alter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/10/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 15, 2006 has been entered.

### ***Response to Arguments***

Applicant's arguments see page 8, filed on August 26, 2005, with respect to the rejection(s) of claim(s) 1-18 under 35 U.S.C. 102(b) and 103(a) have been fully considered but they are not persuasive.

While the Applicant is correct in the assessment that Sarbacher (US 3,610,250) a single unitary housing for the controller, it would have been obvious to incorporate the pulse generator into the controller, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (see MPEP 2144.04). In addition Minogue et al. (US 6,760,629) shows it is well known to use a single unitary housing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5, 7-8 and 10-17 stand rejected under 35 U.S.C. 103(a) as being obvious over Sarbacher (US 3,610,250). Sarbacher discloses the claimed invention except for the single unitary housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the pulse generator into the controller into a single unitary housing since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (see MPEP 2144.04).

In addition it is well known in the art to provide a single unitary housing to include the controller and pulse generator to create a controller for unrestrained movement by the patient.

As previously stated, Sarbacher discloses an electrical contact-carrying garment for muscle stimulation that can be used to cover and treat the upper and lower body. Figure 1 displays the electrodes, which the examiner considers to be the plurality of conductive plates, and the leads, which the examiner considers to be the plurality of conductive strips. The plug receptacle 41 can also be seen in figure 5. The selector switch plug, which is adapted for insertion into the plug receptacle of figure 5, can be seen in figure 7. The examiner considers the selector switch plug to be the electro-stimulating controller, with a plurality of conductive buttons, which enables the attachment to the plug receptacle conductive buttons.

As to claims 3, 11-13 and 17, "the body garments 11 and 12 are fabricated to fit snugly to the body of the user to facilitate electrical contact between the electrodes and the skin of the user, and may preferably be made from a stretch material, such as a knit fabric, or a stretch yarn. The various body-contacting electrodes are affixed to the inside surface of the garment either by an adhesive or by stitching, or the like, and are formed of a flexible conductive material, such as a metal foil or a conductive plastic" (col. 2, lines 68-75). In addition, the "body garment with built in or affixed electrodes appropriately placed to enable selective stimulation of desired muscle areas, Appropriate electrical conductor leads from each of the built in electrodes are affixed to or entwined in the fabric of the garment, and are terminated in one selector switch"(col. 1, lines 52-57). Since the electrodes and leads can be built in or entwined, the examiner considers the strips and plates to be embedded.

As to claim 4, the modified Sarbacher discloses the claimed invention except for the IC circuit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pulse generator as taught by the modified Sarbacher with an IC circuit since it was known in the art to employ IC circuits into pulse generators for computer memory or to function as a microprocessor to provide a low power low capacitance, small circuit.

As to claim 5, the modified Sarbacher discloses the claimed invention except for the wave signal range. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the signal range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering

the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As to claim 7, figure 12 displays an enlarged view of the selector switch and pulse coupling unit coupled together and carried by a garment. The examiner considers the knob 76 to be the stepping switch.

As to claims 8 and 15, figure 2 displays the conductive strips being arranged in parallel formation.

As to claim 10, the conductive strips, also know as the leads, and conductive buttons, which are the selector switch plug and the plug receptacle, are rivet-connected by both a male and female piece, as seen in figures 5 and 7.

As to claim 16, since the body garment is fabricated from a stretch material, the examiner considers it to have elastic bands on the lateral sides. In addition, it is well known in the art to include elastic bands in a garment to enable the garment to snugly fit the patient.

2. Claims 9 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbacher (US 3,610,250) in view of Post et al. (US 6,210,771). Sarbacher discloses the claimed invention except for the overlapping conductive strips and electrically conductive cloth. Post et al. teaches that it is known to use electrically conductive cloth and overlap the conductive strips as set forth in column 1 & 2, lines 66-67 & 1-12 and column 2, lines 42-46, respectively. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrically conductive strips as taught by Sarbacher with the electrically conductive

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cloth as taught by Post et al. since such a modification would allow the garment to be washable and ensure electrical contact with the body.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Alter whose telephone number is (571) 272-4939. The examiner can normally be reached on M-F 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GEORGE R. EVANISKO  
PRIMARY EXAMINER

*Alyssa M. Alter*  
Alyssa M Alter  
Examiner  
Art Unit 3762

*TA*